

REMARKS

Claims presented for prosecution in this Application are claims 1-20. Claims 1-20 have been rejected over cited prior art. In view of Applicants' remarks below, Applicants respectfully submit that claims 1-20 are in condition for allowance. Accordingly, Applicants respectfully request that the present Response be considered and entered, the rejections to the claims be withdrawn, and that the case now be passed to issue.

The 35 USC 112 Second Paragraph Rejection of Claims 7, 8, 15 and 16

The Examiner has rejected claims 7, 8, 15 and 16 as lacking antecedent basis for the term 'idler roller'.

In response, Applicants have amended claims 7, 8, 15 and 16 to provide proper antecedent basis for all terms utilized therein.

In light of the above remarks, Applicants respectfully request that the outstanding 35 USC 112 second paragraph rejection of claims 7, 8, 15 and 16 be withdrawn.

The 35 USC 102(b) Rejection of Claims 1-20 over Knudson

The Examiner has rejected claims 1-20 as being anticipated by Knudson. Applicants respectfully assert that Knudson does not disclose each and every aspect of, at least, newly amended independent claims 1, 9 and 17.

The outstanding Office Action has stated that, "[t]he particular sheet metal article intended to be seamed is of no patentable consequence". Applicants respectfully traverse this assertion. As indicated in MPEP § 2111.02, intended use as recited in the preamble is of patentable consequence if the intended use "breathes life and meaning

into the claim". With respect to claims 1, 9 and 17, Applicants respectfully submit that the intended use recited therein does indeed breath life and meaning into the claims.

That is, the structural configuration of the present invention, including the *structural configuration* and *relative orientation* of the seam rollers themselves, are primarily directed towards addressing concerns that are most readily appreciated in the metal-duct fabrication art.

In addition to the comments above, and solely in an effort to advance prosecution, Applicants have amended claims 1, 9 and 17 in an effort to more clearly recite structure that is simply neither taught nor suggested by Knudson.

The present invention is directed towards a seam closing apparatus for use in the fabrication of sheet metal ducts. As opposed to many known seam closing tools, included the apparatus disclosed in the cited Knudson reference, the seam closing tool of the present invention utilizes one roller having a smooth, uni-planar annular surface operatively coupled with another roller having a groove defined in its annular surface.

In this regard, independent claim 1 now explicitly recites, *inter alia*:

*"a first roller for engaging said outwardly extending sealing portion of said duct seam with a first annular surface, said first annular surface having a uni-planar profile;
a second roller for engaging said lower fold of said duct seam with a groove formed in a second annular surface".*

As clearly shown in the cited Figure 9, Knudson's pair of rollers do not have the structural characteristics recited in claim 1. That is, neither of Knudson's seam rollers includes one which has an annular surface having a uni-planar profile. In contrast, both of Knudson's seam rollers have matching, and undulating, profiles.

Moreover, Applicants respectfully assert there exists no suggestion within Knudson to motivate one of ordinary skill to modify Knudson's seam rollers so as to

meet the structural recitation of the paired rollers, as recited in claim 1. Indeed, Applicants assert that modifying Knudson's paired rollers so as to meet the structural recitation of the paired rollers recited in claim 1 would, in fact, make Knudson's apparatus inoperable.

As Knudson does not disclose or suggest each and every aspect of independent claim 1, Applicants respectfully request withdrawal of the outstanding 35 USC 102(b) rejection of independent claim 1, and those claims dependent thereon, on this basis alone.

With particular respect to independent claim 9, claim 9 now explicitly recites, *inter alia*:

"said pair of opposing rollers being operatively mounted in a step-wise manner such that said pair of opposing rollers are offset from one another".

As can be seen in both Figures 5 and 12 of the present invention, the pair of seam rollers are not oriented in the manner of Knudson's paired rollers. That is, the present invention mounts one seam roller so as to be planarly discontinuous, and stepped down from, the other seam roller. In stark contrast, Knudson reflects the known orientation of seam rollers in which the annular contact surfaces of the paired seam rollers are substantially directly opposing one another.

Similarly, independent claim 17 now explicitly recites, *inter alia*:

"orienting the other of said pair of opposing rollers on said second planar surface, said first planar surface and said second planar surface being discontinuous in a step-wise manner wherein said pair of opposing rollers are oriented to be substantially non-coplanar with one another".

Again, Applicants respectfully assert there exists no suggestion within Knudson to motivate one of ordinary skill to modify Knudson's seam rollers so as to meet the

structural orientation of the paired rollers, as recited in claims 9 and 17. Indeed, Applicants assert that modifying Knudson's paired rollers so as to meet the structural orientation of the paired rollers recited in claims 9 or 17 would, in fact, make Knudson's apparatus inoperable.

As Knudson does not disclose or suggest each and every aspect of independent claims 9 and 17, Applicants respectfully request withdrawal of the outstanding 35 USC 102(b) rejection of independent claims 9 and 17, and those claims dependent thereon, on this basis alone.

Applicants also notes the newly amended subject matter of dependent claims 3 and 4, in which the stepped-down orientation of the paired seam rollers is also recited.

Applicant earnestly believes that independent claims 1, 9 and 17, as well as their associated dependent claims, now clearly define over Knudson, however, should the Examiner believe that there remains any outstanding issues, Applicants respectfully request that the Examiner contact Applicants' Representative so as to expedite resolution of these outstanding issues.

CONCLUSION

In view of the remarks above, it is respectfully submitted that claims 1-20 are allowable, and an early action to that effect is earnestly solicited.

The Examiner is invited to contact the undersigned at the number below to expedite resolution of any issues that the Examiner may consider to remain unresolved. In particular, should a Notice of Allowance not be forthcoming, the Examiner is requested to phone the undersigned for a telephonic interview, an Examiner's amendment, or the like, while the outstanding issues are fresh in the mind of the Examiner.

Authorization is hereby given to charge the Two-Month Extension fee to our Deposit Account No.13-0235. It is believed that no additional fees or deficiencies in fees are owed. However, authorization is also hereby given to charge our Deposit Account No.13-0235 in the event any additional fees are owed.

Respectfully submitted,

By 

Nicholas J. Tuccillo
Registration No. 44,322
Attorney for Applicants

McCORMICK, PAULDING & HUBER LLP
CityPlace II, 185 Asylum Street
Hartford, CT 06103-4102
Tel.: (860) 549-5290
Fax.: (413) 733-4543